

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: ALEXANDER KOLBECK

SERIAL NO.: 09/926,517

FILED: 14 November 2001

FOR: METHOD AND DEVICE FOR SAVING AND
RETRIEVING PIN CODES

GROUP ART UNIT: PCT/DO/EO

EXAMINER: Unassigned

ATTY. REFERENCE: KOLB3001/JEK

PETITION FOR EXTENSION OF TIME

THE COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

Applicant requests that the time for taking action in this case be extended pursuant to 37 CFR 1.136 (a) for:

- ☐ One Month ☐ Three Months
☐ Two Months ☒ Four Months
☐ Five Months

The fee set in 37 CFR 1.17 for the extension of time is \$ 1,450.00.

- ☒ Fee enclosed. Please charge any additional fee required for this extension of time to **Deposit Account Number 02-0200**. A duplicate copy of this paper is enclosed.
- ☐ Charge fee to **Deposit Account Number 02-0200**. A duplicate copy of this paper is enclosed.
- ☐ Applicant is a **small entity** entitled to pay reduced fees in this application.

Also enclosed is a:

- ☐ Response ☐ Notice of Appeal ☐ Appeal Brief
- ☒ Renewed Petition Under 37 C.F.R. 147(b), with declarations

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23364

PATENT TRADEMARK OFFICE

DATE: April 3, 2003

Respectfully submitted,

J. Ernest Kenney
Attorney for Applicant
Registration Number: 19,179

04/07/2003 GFREY1 00000092 09926517

01 FC:1254 ~~1450.00~~ OP

Adjustment date: 00/00/0000

04/07/2003 GFREY1 00000092 09926517

01 FC:1254 -1450.00 OP

06/23/2003 GFREY1 00000152 020200 09926517

01 FC:1255 520.00 DA 1450.00 OP

Rec'd PCT/PTO 03 APR 2003 #6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**PCT/DO/EO
HAND CARRY LEGAL OFFICE**

In re U.S. Patent Application

Attorney Docket: KOLB3001/JEK

Alexander KOLBECK

Serial Number: 09/926,517

Filed: 14 November 2001

For: METHOD AND DEVICE FOR SAVING AND RETRIEVING PIN CODES

RECEIVED
07 APR 2003
International Division

RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)

Commissioner for Patents
Washington, D.C. 20231

Sir:

Reconsideration of the denial of Applicant's petition under 37 C.F.R. 1.47(b) denying acceptance of the application without the signature of the inventor Alexander Kolbeck is respectfully requested.

The original petition filed 12 July 2002 was dismissed because (1) applicant did not provide evidence from an individual with first-hand knowledge that the inventor Kolbeck had been presented with a complete set of application papers and subsequently refused to execute the declaration; (2) the titles of the individuals executing the declaration on behalf of the owner, Giesecke & Devrient GmbH was not indicated in the declaration previously submitted; and (3) the proprietary interest of Giesecke & Devrient GmbH was not properly demonstrated.

This renewed request is accompanied by declarations of Heidrun Teichmann, Thomas Branzka, Andreas Langer, and Siegfried Harms, all employees of Giesecke & Devrient GmbH attesting to the efforts that were made to obtain the signature of the inventor Kolbeck on a declaration for the present application, including the statement of Mr. Harms that a complete copy of the application and a declaration for signature by Mr. Kolbeck was transmitted to him on November 11, 2002 (Harms declaration,

paragraph 6) and that up to the date of Mr. Harms' declaration (April 1, 2003) Mr. Kolbeck has refused to return the signed declaration. All of the statements of Ms. Teichmann, and Messrs. Branzka, Langer and Harms refer to facts within their personal knowledge and reflect numerous attempts to obtain the cooperation of Mr. Kolbeck as early as December 18, 2001 (Teichmann declaration, paragraph 3).

It is respectfully submitted that the declarations of Teichmann, Branzka, Langer and Harms collectively establish that a complete copy of the present application was transmitted to Mr. Kolbeck and that he has refused to execute the declaration for the application up to April 1, 2003. The undersigned attorney of record is not aware that anything has changed from April 1, 2003 up to the date of filing of this renewed petition.

It is respectfully submitted that the first objection to the original petition has now been removed and that it has been demonstrated that a *bona fide* attempt was made to present a copy of the application papers to Mr. Kolbeck for signature and that he has refused to cooperate.

A new declaration is submitted herewith for this application showing the full names and titles of the signatories executing the declaration on behalf of the owner Giesecke & Devrient GmbH. It is respectfully submitted that the new declaration obviates the objection to the declaration submitted with the original application documents.

With respect to the proprietary interest of Giesecke & Devrient GmbH with regard to this application, the declaration of Mr. Harms indicates that he is fully familiar with the German laws relating to employee/inventor rights in inventions made during the course of employment as well as the rights and obligations of the employer. Mr. Harms declares that he complied with all requirements of German patent law relating to the rights of employees and employers with regard to inventions made during the course of employment, and that pursuant to such laws the company Giesecke & Devrient GmbH, the employer of Mr. Kolbeck when the invention was made, owns full interest in the invention and the patent application. Mr. Kolbeck's employment by Giesecke & Devrient GmbH is confirmed in a written statement of employment officials in the

company appended as Exhibit 8 of Mr. Harms' declaration, and other Exhibits appended to the Harms declaration fully support his statements of the relevant facts. Certain invention disclosure documents attached as exhibits to the Harms declaration have been redacted to preserve certain invention dates in secrecy and to preserve applicant's position with respect to a possible interference that could involve the application in the future.

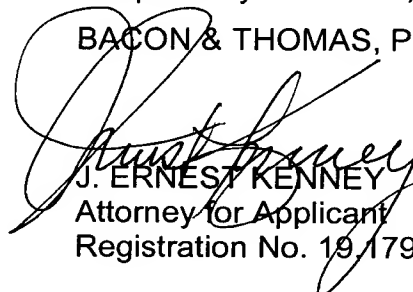
In support of the declaration of Mr. Harms, there is also appended a declaration of Mr. Jochen Höhfeld, a German and European patent attorney, who is also familiar with the laws of Germany relating to employee rights in inventions. Mr. Höhfeld declares that, in his opinion, Giesecke & Devrient GmbH is legally the owner of all rights to the invention disclosed and claimed in this application and that a German court, if presented with the issue of ownership of the invention, would rule in favor of the company. Mr. Höhfeld specifically quotes controlling provisions of the German law relating to employee inventions made during the course of employment in support of his opinion. He also confirm that he has reviewed all of the documents referred to in the declaration of Mr. Harms, as well as the declaration and exhibits of Ms. Teichmann and Messrs. Branzka and Langer when preparing his opinion.

It is respectfully submitted that the proprietary interest of Giesecke & Devrient GmbH, the signatory of the declaration for this application on behalf of and as agent for Alexander Kolbeck has been demonstrated, thereby obviating the third objection to the original petition.

Serial Number: 09/926,517
PCT/DO/EO

In view of the foregoing and the documents submitted herewith, it is respectfully submitted that a favorable decision on the petition is warranted and the same is respectfully requested.

Respectfully submitted,
BACON & THOMAS, PLLC


J. ERNEST KENNEY
Attorney for Applicant
Registration No. 19,179

Date: April 3, 2003



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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NUMBER NO. 09/926,517	FIRST NAMED APPLICANT Alexander Kolbeck	ATTY. DOCKET NO. KOL P3001/JEK
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INTERNATIONAL APPLICATION NO. PCT/EP00/04781
IA. FILING DATE 05/25/2000
PRIORITY DATE

23364
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KOLB3001
Date *12-18-01* Atty *JEK*
Action Due *NTFM Regs*
Deadline *2/12/02*
Final Deadline *3/12/02*

CONFIRMATION NO. 7553
371 FORMALITIES LETTER

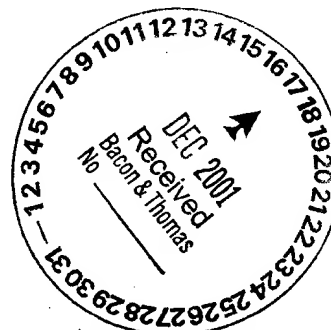
OC000000007180222

Date Mailed: 12/12/2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Oath or Declaration
- Preliminary Amendments
- Request for Immediate Examination



The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
 - is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed

to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

DEBORAH D WILLIAMS

Telephone: (703) 305-3744

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/926,517	PCT/EP00/04781	KOL P3001/JEK